



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

| APPLICATION NO.   | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---------------|----------------------|---------------------|------------------|
| 09/472,490  | 12/23/1999    | RUY TCHAO            | 102-302RE/CO        | 8828             |
| 23869   | 7590          | 02/06/2008           | EXAMINER            |                  |
| HOFFMANN & BARON, LLP<br>6900 JERICHO TURNPIKE<br>SYOSSET, NY 11791 |               |                      | WONG, LESLIE A      |                  |
| ART UNIT  | PAPER NUMBER  |                      |                     |                  |
|   | 1794          |                      |                     |                  |
| MAIL DATE   | DELIVERY MODE |                      |                     |                  |
| 02/06/2008  | PAPER         |                      |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* RUY TCHAO

Appeal 2007-4229  
Application 09/472,490  
Technology Center 1700

Oral Hearing Held: January 16, 2008

<sup>22</sup>Before TEDDY S. GRON, ADRIENE LEPIANE HANLON and CAROL A.  
<sup>23</sup>SPIEGEL, *Administrative Patent Judges*.

1 \* \* \* \*

27 The above-entitled matter came on for hearing on Wednesday,  
28January 16, 2008, commencing at 9:34 a.m., at the U.S. Patent and  
29Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A.  
30Brown, Notary Registration No. 7066896, Notary Public.

31

1Appeal 2007-4229  
2Application 09/472,490

3

1

2

\* \* \* \* \*

3

A P P E A R A N C E S

4

5ON BEHALF OF THE APPELLANT:

6 SALVATORE J. ABBRUZZESE, ESQUIRE  
7 Hoffmann & Baron, LLP  
8 6 Campus Drive  
9 Parsippany, New Jersey 07054  
10 (973) 331-1700  
11 (973) 331-1717 - fax  
12 sabbruzzese@hoffmannbaron.com  
13

14 P R O C E E D I N G S

15 - - - - -

16 THE USHER: Calendar Number 15, Appeal Number 2007-  
174229, Mr. Salvatore Abbruzzese.

18 JUDGE GRON: Mr. Whosie?

19 MR. ABBRUZZESE: Abbruzzi is fine.

20 JUDGE GRON: Counsel, this is Appeal Number 2007-4229  
21for reissue of U.S. Patent 5601997, Tchao. And it is for Chemotaxis Assay  
22Procedure. You have 20 minutes. Proceed.

23 MR. ABBRUZZESE: Thank you. Salvatore Abbruzzese from  
24Hoffmann & Baron. I represent Dr. Tchao and also Becton Dickinson, who  
25is the exclusive licensee of the patent in the application in question.

26 The present reissue application on appeal includes several  
27issues, some of which have been resolved during the prosecution or will be  
28resolved pending the outcome of this appeal. For example, there are no prior  
29art rejections remaining in this case. Also, a new declaration and terminal

1disclaimer will be filed pending a successful outcome on the appeal.

2           The primary unresolved issue before you is the rejections under  
335 USC Sections 251 and 112, first paragraph. Both of these rejections are  
4based on the same premise. Is the claimed subject matter sought by reissue  
5the same invention disclosed in the patent? Stated another way, is the scope  
6of the reissue claimed supported by the specification of the original patent?

7           What this case is not is a case of recapture. The scope of the  
8claims on appeal here have not been given up during prosecution and that is  
9not even being contended by the examiner.

10           The primary inquiry under section 251 is whether one skilled in  
11the art reading the specification could identify the subject matter of the  
12reissue claimed as being disclosed by the patentee in the original application.

13           The inquiry under section 251 is the same as the written  
14description requirement under section 112, first paragraph. The reissue  
15statute, 35 USC section 251, is acknowledged to be remedial in nature. It is  
16based on the fundamental principles of fairness and equity and the Court  
17compelled the statute should be construed liberally.

18           Broad reissue is permitted to cover an embodiment which is not  
19disclosed by the original patent and only discovered later. As long as the  
20disclosure reasonably conveys to one skilled in the art that the applicant had  
21in his possession the invention at the time of the patent.

22           The Federal Circuit wrestling with this issue --

23           JUDGE GRON: All the claims in the patent are to chemotaxis

24--

25           MR. ABBRUZZESE: Chemotaxis assay.

26           JUDGE GRON: -- assay.

27           MR. ABBRUZZESE: That is correct.

1                   JUDGE GRON: And your argument, therefore, is that that  
2doesn't limit the assay procedure.

3                   MR. ABBRUZZESE: That is correct. The disclosure is all  
4based --

5                   JUDGE GRON: We are supposed to disregard that term?

6                   MR. ABBRUZZESE: No, no, no, no, no. Not at all. What I'm  
7urging here is that you have to look at what the invention is that the  
8applicant had at the time of disclosure. My contention is that --

9                   JUDGE GRON: The claimed invention or the invention  
10disclosed in the spec?

11                  MR. ABBRUZZESE: The invention disclosed in the spec.  
12Because that is what -- they didn't have it in his possession at the time of  
13disclosure. Obviously, we wouldn't be here if we were looking at it in the  
14claims. This is a broad reissue.

15                  By definition, we are looking for claimed scope, which is  
16beyond what we originally claimed. We have filed within two years and  
17we're entitled to broaden the claims of the application as long as we can  
18show that the invention is within the possession of the applicant at the time  
19he filed his disclosure.

20                  My contention is that the invention is a nondestructive assay  
21procedure for measuring cell migration across a membrane. That is what the  
22specification entails. In essence, that is the invention.

23                  Of course, the applicant described this with specificity to a  
24chemoattractant. So in the bottom well of the plate, he puts a chemical agent  
25which produces the cell migration-labeled cells on the opposite side of the  
26membrane.

1           But the invention is not limited to that. The invention is the  
2novel assay nondestructive of cell and the novel membrane which allows  
3cell migration from one well to the other. That is what we're seeking by the  
4broad reissue.

5           The prior art doesn't show that. The examiner never contends  
6that we're trying to recapture something that we gave up during prosecution.

7           And according to the case law, reissue must be applied  
8liberally; therefore, we believe we're entitled to the claim of claim 46, the  
9scope of claim 46, which, in essence, describes a novel, nondestructive assay  
10procedure for labeling, for measuring labeled cells, which have migrated  
11through a membrane.

12           JUDGE SPIEGEL: Counsel, when was the underlying patent  
13issued? The issue date was?

14           MR. ABBRUZZESE: Bear with me one second.

15           JUDGE SPIEGEL: Okay.

16           MR. ABBRUZZESE: February 11th, 1997.

17           JUDGE SPIEGEL: What is two years after February 11th,  
181997?

19           MR. ABBRUZZESE: February 11th, 1999.

20           JUDGE SPIEGEL: When was your application filed?

21           MR. ABBRUZZESE: December -- I don't have the original  
22application date. I only have the -- this is a continuation case on a reissue  
23application that has issued where we corrected other errors. There is no  
24issue that we're outside the two-year scope.

25           JUDGE SPIEGEL: So you're relying on the date of the --

26           MR. ABBRUZZESE: Yes. I'm sorry. I didn't know what you  
27were getting at.

1                   JUDGE SPIEGEL: I just wanted to clarify that.

2                   MR. ABBRUZZESE: There is a parent application, which we  
3filed within two years. There was several errors in this case, some of which  
4related to the originally-filed claims, and then there was the issue of a  
5broadening reissue.

6                   The examiner allowed the first set of claims, rejected the  
7broadened claims under 251, 112, first paragraph. So what we did was we  
8filed a continuation to the broadened claims to prosecute that separately and  
9allowed the parent patent to issue. So we claim direct priority to an  
10application which was filed within two years of the issue date of the patent  
11in question.

12                  JUDGE SPIEGEL: Because that chain of dates is not terribly  
13clear on the record. No offense.

14                  MR. ABBRUZZESE: I know. We had very difficult  
15prosecution. I mean, it is not relevant here, but I can explain it to you.

16                  We've had several briefs be filed before you and bounce back  
17either because the examiner having not done something or the applicant not  
18having done something. So I think this is about the fourth brief I've filed in  
19this case never reaching oral argument stage.

20                  It kept getting returned to us for various informalities. So I can  
21understand the confusion in tracking the prosecution in this, but I can assure  
22you that this claim is direct priority to an application which was filed within  
23two years of the issue date.

24                  That is why the issue of whether or not we're entitled to  
25broaden the claims has never come up. It is only whether or not the  
26specification supports the broadened claim that we're trying to get.

26Appeal 2007-4229  
27Application 09/472,490  
28

1                   JUDGE SPIEGEL: And the examiner believes that you are not  
2enabled to go for these claims?

3                   MR. ABBRUZZESE: That is correct.

4                   JUDGE SPIEGEL: And your position is you are because of  
5this membrane you have?

6                   MR. ABBRUZZESE: Yes.

7                   JUDGE SPIEGEL: Are you saying it is not that or are you  
8saying it is the apparatus? I'm not quite clear.

9                   MR. ABBRUZZESE: The method claim. It is the method of  
10measuring nondestructive cell migration.

11                  JUDGE SPIEGEL: Correct.

12                  MR. ABBRUZZESE: And what we do here is we labeled cells  
13in the upper chamber and then --

14                  JUDGE SPIEGEL: So you have a radiation opaque membrane?

15                  MR. ABBRUZZESE: That is correct.

16                  JUDGE SPIEGEL: Chemotaxis -- sorry. You can have cell  
17taxis based on migration to the light.

18                  MR. ABBRUZZESE: Correct.

19                  JUDGE SPIEGEL: That clearly wouldn't work here.

20                  MR. ABBRUZZESE: Sure, it would.

21                  JUDGE SPIEGEL: Why? If it is a radiation opaque membrane  
22--

23                  MR. ABBRUZZESE: It is depending on the wavelength of  
24light. You could have one wavelength that would allow certain labeled cells  
25to migrate and then measure it with a radiation of a different wavelength.  
26And your membrane just has to block the wavelength of your measuring  
27radiation.

1                   JUDGE SPIEGEL: Okay. And you would maintain that one of  
2ordinary skill in the art can situate this membrane such that it would allow  
3cell migration to be trapped when the attractant, if you will, it could be  
4barometric pressure or gravity or water or --

5                   MR. ABBRUZZESE: -- electricity.

6                   JUDGE SPIEGEL: No. Just to be clear. Those are things that  
7are within ordinary skill in the art and you're saying I don't have to give  
8examples or I don't have to tell you how to do it. In fact, I don't have to give  
9examples at all, and I shouldn't be limited to the example I gave because all  
10the rest of this stuff is within ordinary skill. Am I understanding correctly?

11                  MR. ABBRUZZESE: Absolutely. I couldn't have said it  
12better. There are a number of different taxis assays. You named several of  
13them. The examiner named several, was able to tell me right off the bat that  
14these all exist.

15                  What I'm saying is we know they exist, everybody knows they  
16exist. It wouldn't take any undue experimentation to use instead of the  
17chemical attractant, gravity, electricity, light. Any of the other various taxis  
18assays well known in this area and develop.

19                  The membrane is resistive to the wavelength of electromagnetic  
20radiation used to measure the labeled cells that have migrated. That is the  
21invention. The fact that we don't false measure the labeled cells that have  
22not migrated and we have the nondestructive aspect of this is important.

23                  Prior to this, if you didn't use a membrane of this type, you had  
24to scrape away the cells that haven't migrated to avoid getting a false  
25positive. We don't do that. That is clearly set forth in the specification, and  
26I believe it is the real gist of the invention.

36Appeal 2007-4229  
37Application 09/472,490  
38

1                   JUDGE SPIEGEL: The thing is, your specification, it sort of  
2hammers home the point that, for example -- do you have a copy?

3                   MR. ABBRUZZESE: I sure do.

4                   JUDGE SPIEGEL: In column 1 --

5                   MR. ABBRUZZESE: I have it.

6                   JUDGE SPIEGEL: In column 1, lines 5 through 8, this relates  
7to chemotaxis assay procedures and the background discusses, then, the  
8disadvantages of chemotaxis assays and says that -- in column 2, lines 33  
9through 36, it is talking about, this is a chemotaxis assay which avoids the  
10above disadvantages. Disadvantages specifically related to chemotaxis.

11                  MR. ABBRUZZESE: Correct.

12                  JUDGE SPIEGEL: Column 2, line 44 talks about the chemical  
13agent. Column 3, line 35 talks about the chemotaxis procedure of the  
14invention.

15                  MR. ABBRUZZESE: No argument from me. Absolutely  
16correct.

17                  JUDGE SPIEGEL: We've got this dichotomy here where the  
18whole thrust of the specification appears to lead you to we're talking about  
19chemotaxis.

20                  MR. ABBRUZZESE: I don't disagree with you on that, but  
21what we have to look at and what the case law says we look at is, what is the  
22invention? And the invention is not limited to chemotaxis. It is the  
23embodiment known by the inventor at the time he came up with this.

24                  But at all times, he recognized the fact that it was a novel  
25membrane in a nondestructive assay.

26                  I refer you to column 5 of the specification carrying over to  
27column 6 where they talk about the invention and they talk about the

41Appeal 2007-4229  
42Application 09/472,490  
43

1membranes permitting measurement of the radiation from the labeled cells  
2that migrated through the radiation opaque membrane. The whole paragraph  
3doesn't mention chemotaxis.

4                   It talks about cell migration, radiation opaque membrane.  
5Someone reading that could certainly say, I can use gravity to affect that. I  
6could use electricity. I could use other wavelengths of light. This just  
7happened to be described for use with a chemical attractant.

8                   JUDGE GRON: Has the examiner made any showing in this  
9case to back up his statement that any of these other procedures would be  
10not enabled, he alleges they are not, but do you know if there is other  
11information --

12                  MR. ABBRUZZESE: I have found none. The examiner -- one  
13of my contentions is the examiner merely makes the statement that undue  
14experimentation would be necessary and she didn't --

15                  JUDGE GRON: Did he point to any references?

16                  MR. ABBRUZZESE: She didn't support it at all.

17                  JUDGE GRON: None at all. Who has the burden of proof in  
18this case?

19                  MR. ABBRUZZESE: I would think the examiner would  
20because the reissue statute is positive in nature in that it says you shall be  
21entitled to.

22                  JUDGE GRON: Any more? Thank you, Counsel.

23                  MR. ABBRUZZESE: Thank you very much.

24                  (Whereupon, the proceedings at 9:49 a.m. were concluded.)

1 CERTIFICATE OF REPORTER

2 I, Dawn A. Brown, do hereby certify that the foregoing  
3 proceedings were taken by me in stenotype and thereafter reduced to  
4 typewriting under my supervision; that I am neither counsel for, related to,  
5 nor employed by any of the parties to the action in which these proceedings  
6 were taken; and further, that I am not a relative or employee of any attorney  
7 or counsel employed by the parties hereto, nor financially or otherwise  
8 interested in the outcome of the action.

9

10  
11

Dawn A. Brown